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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/193,647 11/17/98 USNER

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| EXAMINER |
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2161
DATE MAILED:

03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/193,647

Applicant(s)

Usner At Al.

Examiner

Tongoc Tran

Group Art Unit

2161

☒ Responsive to communication(s) filed on Nov 17, 1998

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This Office Action is in response to Applicant's application filed on 11/17/1998. Claims 1-15 are presented for examination.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it is unclear what the phrase "the status is representative of a fault in the transaction function device" is referencing. For the purpose of executing the case, the examiner is

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assuming that applicants intend the status is referring to error message of the transaction function device when there is a "fault" or error appears in the transaction.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-5, 7-8, 11-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Bank Network News (hereinafter Banknet), "Internet Technology Pushes New Services to ATMs", 4/11/1997).

Regarding to claim 1, Banknet discloses an apparatus comprising:

an automated transaction machine including at least one transaction function device, a server in operative connection with the transaction function device at least one HTML document accessible through the server, wherein at least one first document includes indicia corresponding to a status of the transaction function device (see page 1, paragraph 3 and page 2 paragraph 1, the limitation is met because a transaction function device is inherently required in order for the tickets to be printed out at ATM, a server and HTML document is inherently required in order to interact via the Internet at the ATM).

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Regarding to claim 2, Banknet discloses the apparatus according to claim 1 wherein the transaction function device is operative responsive to an HTTP message receive by the server (see page 2, paragraph 1).

Regarding to claim 3, Banknet discloses the apparatus according to claim 1 wherein the status is representative of a fault in the transaction function device (see page 2, paragraph 1, error message corresponding to transaction is inherently required in any transaction order to ensure transaction function is being processed correctly).

Regarding to claim 4, Banknet discloses the apparatus according to claim 1 wherein the machine includes a plurality of transaction function devices, and wherein the HTML document accessible through the server include indicia corresponding to a status of each of a plurality of transaction function devices (see page 2, paragraph 1 and 9, it is inherently required for a web ATM to include plurality of transaction function devices, i.e. transaction request for dispensing cash or tickets).

Regarding to claim 5, Banknet discloses the apparatus according to claim 1 wherein the machine is an ATM (see page 1).

Regarding to claim 7, Banknet discloses a method comprising:
operating a transaction function device in an automated transaction machine, the transaction function device having an associated status; and
generating at least one first HTML document including first instructions corresponding to the status of the transaction function device (see page 1, paragraph 3 and page 2 paragraph 1, the

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limitation is met because a transaction function device is inherently required in order for the tickets to be purchased and printed out at ATM, a HTML document is inherently required in order to interact through via the Internet at the ATM, a transaction device having an associated status is inherently required when request is made for cash withdrawal or printing out of a ticket).

Regarding to claim 8, Banknet discloses the method according to claim 7 and further comprising the step of accessing the first document with a terminal including a browser (see page 2, paragraph 1, accessing the first document with a terminal including a browser is inherently required in order to accessing the Internet).

Regarding to claim 11, the method according to claim 7, and further comprising the steps of receiving a second HTML document with the machine, the second document including second instructions; and operating the transaction device responsive to the second instructions (see page 2, paragraph 1 and 9, the limitation is met because a web ATM that provide request for services through the Internet is inherently required to receive a second HTML document and instruction and operating the transaction device responsive to the second instruction in order to provide customer subsequent request for services).

Regarding to claim 12, Banknet discloses an apparatus comprising:

an automated transaction machine including a plurality of transaction function devices, wherein each of the transaction function devices has an associated status, wherein the status is indicative of an operation of the transaction function device (see page 2, paragraph 1 and 9, it is

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inherently required for a web ATM to include plurality of transaction function devices and an associated status, i.e. transaction request for dispensing cash or tickets);

a transaction machine computer in operative connection with the transaction function devices, and further comprising machine software executable in the computer, wherein the software is operative to cause the computer to generate at least one HTTP record including indicia representative of the status of at least one transaction function device, and wherein the software further includes a server, wherein the first HTTP record is accessible through the server (see page 1, paragraph 3 and page 2 paragraph 1, the limitation is met because a transaction function device is inherently required in order for the tickets to be printed out at ATM, a server and HTML document is inherently required in order to interact via the Internet at the ATM and it is further inherent that a transaction machine computer (ATM) is in operative connection with the transaction function devices in order to perform request service such as cash withdrawal).

Regarding to claim 13, the apparatus according to claim 12 wherein the HTTP record comprises an HTML document (see page 2, paragraph 1, a HTTP document is inherently required in a web ATM).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6, 9, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bank Network News (hereinafter Banknet), "Internet Technology Pushes New Services to ATMs", 4/11/1997).

Regarding to claim 6, Banknet discloses the apparatus according to claim 1. Banknet does not explicitly discloses and a portable terminal, wherein the portable terminal includes a browser, wherein the terminal is operative to access documents through the server.

However, Official Notice is taken that portable computer is old and well known, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the Internet enabling ATM of Banknet on a PC for the benefit of maintaining the system.

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Regarding to claim 9, Banknet discloses the method according to claim 8. Banknet does not explicitly discloses the accessing step includes accessing the first document with a portable terminal adjacent to the automated transaction machine.

However, Official Notice is taken that accessing Internet through a portable computer is old and well known. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the web ATM taught in Banknet with portable terminal adjacent to the automated transaction machine for the convenient of customer.

Regarding to claim 14, Banknet discloses the apparatus according to claim 12 . Even though Banknet does not explicitly teach that the HTTP record comprises a data object. However, most software development for the Internet are implemented in Java which is an object oriented programming. Therefore, it would have been obvious that the HTTP record taught in Banknet would have been implemented using JAVA programming to encapsulate file record into data object for reusable benefit.

Regarding to claim 15, the apparatus according to claim 14 and further comprising a terminal computer outside the automated transaction machine, a communications connection operatively connecting the transaction machine computer and the terminal computer, and further comprising terminal software in terminal computer, wherein the terminal software and the machine software are operative to transfer the data object from the transaction machine to the terminal computer (see page 1, an ATM machine is inherently connected to a host computer which is a terminal computer outside the automated transaction machine, it required a

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communication network to connect the ATM with the host machine (terminal computer), and software is inherently required to operate said computer. Information is inherently transmitted between the host computer and the ATM machine).

Even though Banknet does not explicitly disclose what programming language is implemented in the ATM machine.

However, object oriented programming is old and well known, it would have been obvious to implement Banknet's web ATM machine with object oriented technique for transferring data object between the ATM machine and the host machine for reusable benefit.

7. Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bank Network News (hereinafter Banknet), "Internet Technology Pushes New Services to ATMs", 4/11/1997) in view of Zeanah et al. (hereinafter Zeanah) (U.S. Patent No. 5,933,816).

Regarding to claim 10, Banknet discloses the method according to claim 8. Banknet does not explicitly disclose the accessing step includes accessing the first document through a network with a terminal located remotely from the automated transaction machine.

However, Zeanah discloses providing financial services to a remote device through an Internet (see col. 6, lines 1-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Zeanah's remote accessing document through an Internet

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with Banknet's teaching of web ATM with the terminal located remotely from the automated transaction machine for providing consistent services to customers.

Conclusion

8. Claims 1-15 are rejected.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Pistriotto et al. discloses a method and apparatus for configuring a client to redirect request to a caching proxy server based on a category ID with the request.

-Hassett et al. discloses an apparatus method and article of manufacture for servicing client request on a network.

-Eaton discloses a multi-transaction service system in financial service.

-Klingman discloses on-line secured financial transaction system through electronic media.

-Ginzboorg et al. implementation of charging in a telecommunication system.

-Home banking & financial Service discloses in "Turning automated banking machines into automated browsing machines", the incorporation of Internet technology into ATM.

-PR Newswire discloses in "Diebold Introduces Microsoft-Supported ATM Internet Software with Key bank", Keybank and Diebold incorporated a new ATM .

-Computergram International discloses, "Net-enabled automated teller machines win Microsoft support", incorporates other services into ATM.

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-PR Newswire discloses in "Diebold and Wells Fargo Bank demonstrate web-enabled ATM achitecture" the incorporation of ATM with Internet technology.

-Caldwell, B. discloses in "ATMs mission: generate profits", marketing ATM for profit.

-HK Economic Times discloses in "IBM launches Internet ATM", IBM lauching the first web ATM.

-EFT Report discloses in "1997 to emerge as the golden year of ATMs" the different vendors that involved in the ATM market.

-Block, V. discloses in "Home banking displaced teller machines at retail delivery conference", the key players in the Retail Delivery '96 conference.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-0040, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021
Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran, whose telephone number is (703) 305-8967 and whose e-mail


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address is Tongoc.Tran@uspto.gov. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768. The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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08Mar01



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